

### **Remarks / Arguments**

Claims 1-6, 8-9 and 11-14 are pending. Claims 7 and 10 have been canceled previously. Claims 1-6, 8-9 and 11-14 have been amended. No new matter has been added.

#### **General remarks**

Claims 11 and 12 have been amended to refer to the “composition” instead of “compound” of claim 8, for proper antecedent basis.

Claims 1-6 have been converted into the singular form to bring them into the usual US format.

#### **Election/Restrictions**

The examiner recommended that the applicants cancel non-elected subject matter in this response, and required deletion of “any substituents on R<sup>9</sup>, R<sup>10</sup>, R<sup>11</sup>, R<sup>12</sup>, R<sup>13</sup>, or R<sup>14</sup> that do not form phenyl.” He provided an example of what should be deleted by reference to group R<sup>9</sup>, and required applicants to make the same amendment to the groups R<sup>10</sup>, R<sup>11</sup>, R<sup>12</sup>, R<sup>13</sup>, and R<sup>14</sup>.

The applicants had difficulty when attempting to respond to this directive, as it became clear that the original restriction requirement was incomplete. That restriction requirement mandates that the claims contain no heterocycles, but only discusses the R<sup>6</sup> group, leaving all other groups of the formula, as well as all included substituent groups, undiscussed.

The applicants have in this response deleted all heterocycles, and have amended the definition of the R<sup>6</sup> group in accordance with the examiner’s directions. If the examiner’s review raises any further questions regarding the restriction issue with respect to various substituent groups or moieties other than R<sup>6</sup> of the formula (I), the applicants will have to address these in the next response.

Applicants reserve the right to prosecute all non-elected subject matter in one or more divisional applications.

### **Abstract**

The abstract was objected to on grounds that it is not descriptive. It has now been replaced with a rewritten abstract.

### **Claim Rejections - 35 U.S.C. § 103**

Claims 1-6, 8, 9 and 11-14 were rejected under 35 U.S.C. §103 as being unpatentable over Apelqvist et al. (WO 00/07972) on ground that Apelqvist discloses the synthesis of diphenyl derivatives linked by –O– and having benzoyl attached at 2-position, which the examiner characterizes as positional isomers of certain of the claimed compounds.

In the present amendment applicants have deleted MR<sup>14</sup> from the definition of the group R<sup>6</sup>, thereby moving the claim scope away from the subject matter of the reference. It is deemed that the disclosure of the cited reference does not suggest the presently-claimed materials, and accordingly, the rejection is now deemed overcome.

### **Claim Rejections - 35 U.S.C. § 112, first paragraph**

Claims 11-13 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement on grounds that the method of preventing was not described in the specification in such a way as to enable one skilled in the art to make or use the invention.

Applicants have amended claims 11-13 to delete the terms “preventing” and “prophylaxis”, rendering the rejection moot.

### **Claim Rejections - 35 U.S.C. § 112, second paragraph**

Claims 1-6, 8, 9 and 11-14 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite on the grounds indicated below. In each case, the applicants’ response is summarized.

a) Ground: claim 1 and claims dependent thereupon recite the expression “general formula”. Claim 1 and claims dependent thereupon have been amended to delete “general” in reference to the formula, rendering the rejection moot.

b) Ground: claim 4 recites the expression “in particular”. Claim 4 as well as claims 5 and 6 in the definition of R<sup>3</sup> and R<sup>4</sup> have been amended to delete “in particular”, rendering the rejection moot.

c) Ground: claim 12 recites the expression “disease forms which can be treated with natural thyroid hormone”. Claim 12 has been amended to delete “disease forms which can be treated with natural thyroid hormone”, but instead to recite “depression, goiter or cancer of the thyroid gland” (as disclosed in the specification as filed, page 41, line 18 *et seq.*), rendering the rejection moot.

d) Ground: claim 13 recites the expression “prophylaxis of disorders”. Claim 13 has been amended to delete “prophylaxis” and recite “arteriosclerosis, hypercholesterolaemia, dyslipidaemia, obesity, cardiac insufficiency, pulmonary emphysema, pain, migraine, Alzheimer's disease, osteoporosis, cardiac arrhythmias, hypothyroidism, skin disorders or diabetes” instead of “disorders”, rendering the rejection moot.

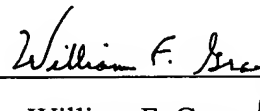
In view of the above amendments and arguments, this application is deemed to be in condition for allowance, and allowance is accordingly requested.

Respectfully submitted,

Reg. No.: 31018

Phone: (203) 812-2712

Date: 12/30/03



William F. Gray

Bayer Pharmaceuticals Corporation

400 Morgan Lane

West Haven, CT 06516-4175